Remarks:

Reconsideration of the application is requested.

Claims 1-20 are now in the application. Claims 1, 3, 7, 12, and 15 have been amended. A marked-up version of the claims is attached hereto on separate pages. Claims 7 and 9-11 have been cancelled. Claims 16-19 have been added. Support for claim 16 can be found on page 11, lines 2-6 of the specification. Claim 17 corresponds to claim 12. Claim 18 corresponds to claim 13. Claim 19 corresponds to claim 14. claim 20 corresponds to claim 2. No new matter has been added.

In the first paragraph on page 2 of the above-identified Office action, the drawings have been objected to because in Figure 4, the reference numeral "85" has been used twice to designate both the insulation and the groove-like receptacle. Figure 4 has been changed so as to correct the typographical error, and the insulation has been designated "86" to correspond with the specification.

In the third paragraph on page 2 of the Office action, the Examiner has stated that on page 14, line 18, "holding element 63 faces the edge" should be changed to --holding element 61 faces the edge-- in order to agree with what has been shown in

the drawing. The specification has been amended so as to correct the typographical error.

In fifth paragraph on page 2 of the Office action, claim 1-15 have been objected to as being indefinite under 35 U.S.C. § 112.

More specifically, the Examiner has stated that with respect to claim 1, it is unclear what is being claimed with the recitation of the couple being "thermally uncoupling" from the edge portion, lines 11-12. The Examiner continues to ask how can a plastic coupling perform "thermally uncoupling". It is noted that the plastic couple is a thermally insulating couple such that it does not allow a good thermal conduction between the inner and outer panelings. The couple substantially thermally uncouples the free edge portion from the edge portion. Therefore, claim 1 has not been amended to overcome the objection by the Examiner.

The Examiner stated that with respect to claim 3, it is unclear what constitutes "liquid tight manner" because it has not yet been defined. The Examiner is directed to page 11, lines 10-23 of the specification. Based on the description the phrase "liquid tight manner" is believed to be clear. Therefore, the claim 3 has not been amended to overcome the objection by the Examiner.

The Examiner also stated that claim 7 fails to claim a door seal because the recitation of "to be connected" alludes to the merit of purposes. Claim 7 has been cancelled from the application. Therefore, the objection by the Examiner is now moot.

The Examiner stated that with respect to claim 12, it is unclear what constitutes "a special-steel blank". Claim 12 has been amended to facilitate prosecution of the application. Therefore, the objection by the Examiner is now moot.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic or clarificatory reasons. The changes are not provided for overcoming the prior art nor for any reason related to the statutory requirements for a patent.

In the third paragraph on page 3 of the Office action, claims 1-5, 7-10, and 15 have been rejected as being fully anticipated by Pasqualini et al. (U.S. Patent No. 4,617,759) under 35 U.S.C. § 102.

The rejections have been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. Support for the changes is found in claim 2 of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

> a thermally insulating couple being a fastening element of a door seal and connecting the edge portion to the free edge portion.

The Pasqualini et al. reference discloses a plastic profile equipped with a bellows gasket portion that is a integral co-extruded piece made from two different materials having a different rigidity (column 1, line 65 to column 2, line 5). The reference further discloses that the profile (1) is made from a rigid plastic such as PVC, and has an integral gasket portion (18) of flexible plastic or elastomeric material (column 2, lines 54-58).

The reference does not show a thermally insulating couple being a fastening element of a door seal and connecting the

edge portion to the free edge portion, as recited in claim 1 of the instant application. Pasqualini et al. disclose a fastening profile and seal made of two materials: a rigid plastic and an elastomeric material. This is contrary to the invention of the instant application as claimed and as shown in Figs. 2-3, in which the fastening element and seal are one-piece construction of uniform material.

Since claim 1 is believed to be allowable, the dependent claims are believed to be allowable as well.

In the first paragraph on page 4 of the Office action, claims 1-15 have been rejected as being obvious over Beck (U.S. Patent No. 2,659,940) in view of Gerritsen (U.S. Patent No. 4,305,230) under 35 U.S.C. § 103.

The Beck reference discloses a fastener and a separate seal that is attached to the fastener.

The Gerritsen reference also discloses a fastener and a separate seal that is attached to the fastener.

The references do not show or suggest a thermally insulating couple being a fastening element of a door seal and connecting the edge portion to the free edge portion, as recited in claim 1 of the instant application. Since both Gerritsen and Beck

disclose a seal that is a separate part from the fastener the combination of the references does not lead to the invention of the instant application in which the fastening element and seal are one-piece construction of uniform material.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be '**clear and particular.**'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis

added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Beck to incorporate the features of Gerritsen, and there is no teaching or suggestion in Gerritsen to incorporate the features of Beck.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Beck or Gerritsen or to combine Beck's and Gerritsen's teachings to arrive at the claimed present invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Beck or

Gerritsen or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Claims 15 and 16 call for *inter alia*:

> an inner paneling having an edge portion and being made from metallic material, the inner paneling spaced from the outer paneling, and the free edge portion and the edge portion being vertically offset in parallel planes.

None of the references cited show or suggest an inner paneling having an edge portion and being made from metallic material, the inner paneling spaced from the outer paneling, and the

free edge portion and the edge portion being vertically offset in parallel planes, as recited in claims 15 and 16. All of the references cited disclose that the free edges and edge portions are in the same plane.

Furthermore, there is no motivation in the references to dispose the free edge and the edge such that they are vertical offset from each other in parallel planes.

Since claim 16 is believed to be allowable, the claims dependent therefrom are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1, 15, or 16. Claim 1, 15, and 16 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 or 16, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-24 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone

call so that, if possible, patentable language can be worked out.

Petition for extension is herewith made. The extension fee for response within a period of 3 months pursuant to Section 1.136(a) in the amount of $930 in accordance with Section 1.17 is enclosed herewith.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,

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For Applicant(s)

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ZTP99P4011 P

Marked-up version of the claims:

Claim 1 (amended). A refrigerator door, comprising:

an outer paneling having a free edge portion and being made from a metallic material;

an inner paneling having an edge portion and being made from metallic material, said inner paneling spaced from said outer paneling;

a thermal insulation layer produced by foaming, said thermal insulation layer disposed between said outer paneling and said inner paneling;

a thermally insulating couple being a fastening element of a door seal and connecting said edge portion to said free edge portion, said couple substantially thermally uncoupling said edge portion from said free edge portion.

Claim 2 (amended). The refrigerator door according to claim [1] 16, wherein:

said thermally insulating couple is a plastic fastening element of a door seal; and

said fastening element is disposed between said edge portion and said free edge portion.

Claim 3 (amended). The refrigerator door according to claim [1] 16, wherein said thermally insulating couple is a plastic profile with a receptacle, said plastic profile:

is disposed between said edge portion and said free edge portion; and

bridges said edge portion and said free edge portion in a substantially liquid-tight manner; and

including a door seal, said receptacle releasably holding said door seal.

Claim 8 (amended). The refrigerator door according to claim [7] 3, wherein:

said plastic profile has at least one receptacle; and

at least one of said edge portion and said free edge portion is inserted into said at least one receptacle.

Claim 12 (amended). The refrigerator door according to claim 1, wherein said inner paneling is formed from a [special-steel] steel blank.

Claim 15 (amended). A refrigerator door, comprising:

an outer paneling having a free edge portion and being made from a metallic material;

an inner paneling having an edge portion and being made from metallic material, said inner paneling spaced from said outer paneling, and said free edge portion and said edge portion being vertically offset in parallel planes;

a thermal insulation layer produced by foaming, said thermal insulation layer being disposed between said outer paneling and said inner paneling;

a means for thermally insulatingly coupling said edge portion to said free edge portion, said coupling means substantially thermally uncoupling said edge portion from said free edge portion.

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Marked-up version of the specification:

Replace the paragraph between page 13, line 16 and page 15, line 5 with the following:

-- FIG. 3 illustrates a further embodiment of a refrigerator door 50, configured as a freezer cabinet door. The refrigerator door 50 has an outer paneling 51 that serves as a visible cover and is manufactured from metallic material. Like the outer claddings 11, 31, the outer cladding 51 has a peripherally disposed surround 52 with a free edge portion 53 that is directed into the door interior. An inner paneling 54 is provided spaced from the outer paneling 51. The an inner paneling 54 is likewise shaped from blank-like material, such as, for example, special steel or the like, and, like the inner panelings 14, 34, has, in a region near its edge, a peripherally disposed step-like shoulder 55 with a free edge portion 56. The free edge portion 56 is directed in the direction of the free edge portion 53, but is disposed, offset vertically in a parallel plane and spaced from the free edge portion 53, thereby providing a clearance 57 disposed peripherally between the free edge portions 53, 56. In the embodiment, the clearance 57 is bridged by a fastening element belonging to a magnetic seal 58 and configured as a seal foot 59. The seal foot 59, like the plastic profile 17, possesses

two holding elements 60, 61 that are integrally formed in a strip-like manner. Each of the two holding elements 60, 61 has a receiving groove 62 that is open toward the respective edge portions 53, 56 and that is coordinated in terms of its groove width with the material thickness of the respective edge portion 53, 56. Of the receiving grooves 62, the groove 62 provided on holding element 60 is connected in a liquid-tight manner to the free edge portion 53. The receiving groove 62 disposed on holding element [63] 61 faces the edge portion 56 and is connected in a liquid-tight manner to the edge portion 56. In addition to the holding elements 60, 61 on the seal foot 59, the magnetic seal 58 possesses a seal head 63 that is connected elastically to the seal foot 59. The magnetic seal 58, with its seal foot 59 inserted in a liquid-tight manner as an intermediate element into the clearance 57, surrounds, together with the outer paneling 51 and the inner paneling 54, a cavity that is filled with foamable thermal insulation material 64. The thermal insulation material 64, by virtue of its adhesive action, connects the inner paneling 54, the outer paneling 51, and the magnetic seal 58 to form an, as far as possible, dimensionally rigid and distortion-resistant subassembly.--

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Fig. 4